

REMARKS

Claim 1 has been amended to set forth the invention in more positive form. Claim 4 has been canceled. Claims 5-7 have been withdrawn from consideration. Claims 8 and 9 have been added. No new matter has been added.

In the pending Office Action, claims 1-4 were rejected under 35 USC 103(a) as being unpatentable over the abstract of Sugimori et al. (JP 2192826) in view of the abstract of Miura (JP 2002-316226). Applicants respectfully traverse the rejection.

Applicants first note that MPEP Section 706.02 II states that reliance on an abstract without reliance on the underlying scientific document is inappropriate when both the abstract and the underlying document are prior art. If the underlying document is in a language other than English, a translation must be obtained. In the pending rejection, the Examiner improperly relied on only the abstract and drawings of Sugimori and Miura. To expedite examination and allowance of this application, applicants provide translations of both documents with this response.

To establish *prima facie* obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all of the claim limitations. MPEP 2143.

Sugimori and Miura do not teach or suggest all of the limitations of the claims as amended. Claim 1 recites that the border portion of the metal plate is compressed to have a thickness that is at least 70% of a thickness of the metal plate before drawing. Contrary to the Examiner's contention, the plate illustrated in the figures of Sugimori does not teach or suggest this limitation. The Examiner bases his contention on the patent drawings, which he admits are often not drawn to scale. Applicants have reviewed Sugimori and found that it does not disclose that its figures are drawn to scale or demonstrate the claimed 70% thickness even if they were drawn to scale. According to *In re Wright*, 569 F.2d 1124, 1127 (Fed. Cir. 1976) (disagreeing with the Solicitor's arguments supporting an outstanding obviousness rejection), absent any

written description in the specification of quantitative values, arguments based on measurement of a drawing are of little value when the drawings are not disclosed to be to scale). The holding of *In re Wright* was followed by *Hockerson-Halberstadt, Inc. v. Avia Group Int'l, Inc.*, 222 F.3d 951 (Fed. Cir. 2000) (stating that it is well established that patent drawings do not define the precise portions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue), and *Nystrom v. Trex Co.*, 374 F.3d 1105 (Fed. Cir. 2004) (stating that the district court's acceptance of invalidity arguments based on models made from patent drawings was incorrect because patent drawings do not define the precise portions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue).

Miura does not disclose a compressed border portion at all. Without a teaching or suggestion of this limitation in claim 1, the cited references do not make out a *prima facie* case of obviousness, and the rejection under 35 USC 103(a) must be withdrawn. In addition, the Examiner has not explained why a person of ordinary skill in the art would have been motivated to combine the teachings of Sugimori and Miura, which is required to establish *prima facie* obviousness. Claims 2, 3, 8, and 9 depend from claim 1 and are therefore allowable for the same reasons.

In view of the above, the pending claims are in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

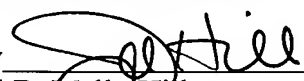
In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in

connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 325772033800.

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Respectfully submitted,

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Attachments: Translations of JP 2-192826 and JP 2002-316226